AP

PTO/SB/21 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)			
		Application Number	09/732,024
		Filing Date	December 8, 2000
		First Named Inventor	Newman, Paula S.
		Art Unit	2144
		Examiner Name	Thanh Nguyen
Total Number of Pages in This Submission		Attorney Docket Number	A0836

ENCLOSURES *(Check all that apply)*

[X] Fee Transmittal Form	[ ] Drawing(s)	[ ] After Allowance communication to (TC)
[ ] Fee Attached	[ ] Licensing-related Papers	[ ] Appeal Communication to Board of Appeals and Interferences
[ ] Amendment / Reply	[ ] Petition	[X] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
[ ] After Final	[ ] Petition to Convert to a Provisional Application	[ ] Proprietary Information
[ ] Affidavits/declaration(s)	[ ] Power of Attorney, Revocation Change of Correspondence Address	[ ] Status Letter
[ ] Extension of Time Request	[ ] Terminal Disclaimer	[X] Other Enclosure(s) (please identify below):
[ ] Express Abandonment Request	[ ] Request for Refund	Postcard
[ ] Information Disclosure Statement	[ ] CD, Number of CD(s) _____	
[ ] Certified Copy of Priority Document(s)	[ ] Landscape Table on CD	
[ ] Reply to Missing Parts/ Incomplete Application		
[ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53		

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Law Offices of Patrick J.S. Inouye		
Signature	Patrick J.S. Inouye		
Printed name	Patrick J.S. Inouye		
Date	January 17, 2006	Reg. No.	40297

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Signature	Larissa Pigott		
Typed or printed name	Larissa V. Pigott	Date	January 17, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

In you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/17 (12-04)
Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/8/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2005

☐ Applicant Claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 500.00

Complete if Known	
Application Number	09/732,024
Filing Date	December 8, 2000
First Named Inventor	Newman, Paula S.
Examiner Name	Thanh Nguyen
Art Unit	2144
Attorney Docket No.	A0836

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 24-0037 Deposit Account Name: Xerox Corporation

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charges fee(s) indicated below, **except for the filing fee**

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	Fee ($)	Fee ($)	Fee ($)	Fee ($)	Fee ($)	Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 20 or HP =	_____	x _____	= _____

HP = highest number of total claims paid for, if greater than 20

Indep. Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 3 or HP =	_____	x _____	= _____

HP = highest number of independent claims paid for, if greater than 3

Multiple Dependent Claims	
Fee ($)	Fee Paid ($)
_____	_____

3. APPLICATION SIZE FEE

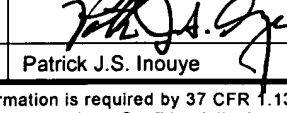
If the specification and drawings exceed 100 sheets of paper, the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41 (a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
_____ - 100 =	_____	/ 50 = _____ (round up to a whole number)	x _____	= _____

4. OTHER FEE(S)

	Fees Paid($)
Non-English Specification, $130 fee (no small entity discount)	
Other: Appeal Brief Fee: $500.00	500.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 40297	Telephone (206) 381-3900
Name (Print/Type)	Patrick J.S. Inouye		Date January 17, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Paula S. Newman et al.	Group Art Unit: 2144
Serial No. 09/732,024	Examiner: Thanh Nguyen
Filed: December 8, 2000	
For: Method And Apparatus For Presenting E-Mail Threads As Semi-Connected Text By Removing Redundant Material	

APPEAL BRIEF

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON BEHALF OF PAULA S. NEWMAN ET AL:

Appellant appeals from the Office action mailed July 13, 2005, in which currently-pending claims 1, 3-10, 12-18, and 20-27 stand rejected. Appellant filed a Notice of Appeal on November 14, 2005. This appeal is being timely filed within two months of the mailing date of the Notice of Appeal, which occurred on a weekend followed by a federal holiday. 37 CFR 1.7(a).

TABLE OF CONTENTS

1. REAL PARTY IN INTEREST

The real party in interest is assignee Xerox Corporation, a New York corporation, located at 800 Long Ridge Road, P.O. Box 1600, Stamford, CT 06904-1600.

2. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellant, Appellant's legal counsel, or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal

3. STATUS OF CLAIMS

Claims 1, 3-10, 12-18, and 20-27 are rejected and pending, which are also the subject of this appeal. An Appendix setting forth the Claims on appeal is included as Section 10, *infra*.

4. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection of Claims 1, 3-10, 12-18, and 20-27. Claims 1, 10, 18 and 26 were previously amended and Claims 2, 11, and 19 were canceled in an Amendment and Response to Office Action, filed on January 7, 2005.

5. SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim 1

Claim 1 defines a method for presenting email threads (p. 6, lines 1-5; p. 9, line 20-p. 10, line 23). The logical components of each message in a thread are identified (p. 6, lines 6-10), which includes dividing the message into a main body and excerpts from other messages that are either embedded in the main body or suffixed, as well as decomposing these sections into group types, such as text-blocks, tables, contact information, and the like. The relationships between the messages in the thread are determined using the logical components (p. 7, line 31-

p. 8, line 15), which uses the logical components to match excerpts with their sources and to identify predecessor or predecessors for each message. If possible, each excerpt is matched to its source. Otherwise, predecessors are found based on a combination of evidence, including header fields, header fields of included messages, excerpted text, and the like. A document based upon the determined relationships is generated, wherein any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated document does not include the redundant logical components (p. 8, line 16-p. 9, line 19). In a first presentation technique, messages are presented in a semi-linear message sequence in which embedded quotes are abbreviated, included messages are eliminated and links are provided to allow full access to the quotes (p. 4, lines 4-7; p. 5, lines 29-31). In a second presentation technique, blocks are presented that constitute responses to a particular passage as annotations to the passage in the original message via in-lining, margin text, framing, links or other similar display strategies (p. 4, lines 7-9; p. 5, lines 31-34).

B. Independent Claim 10

Claim 10 defines a computer controlled display system (p. 6, lines 1-5; p. 10, line 25-p. 11, line 14). A display is configured for presenting e-mail threads on a viewing area of the display (p. 10, line 25-p. 11, line 14). A processor is adapted to identify the logical components of each message in a thread (p. 6, lines 6-10), which includes dividing the message into a main body and excerpts from other messages that are either embedded in the main body or suffixed, as well as decomposing these sections into group types, such as text-blocks, tables, contact information, and the like. The processor is further adapted to determine the relationships between each message in the thread using the logical components (p. 7, line 31-p. 8, line 15), which uses the logical components to match excerpts with their sources and to identify predecessor or predecessors for each message. If possible, each excerpt is matched to its source. Otherwise, predecessors are found based on a combination of evidence, including header

fields, header fields of included messages, excerpted text, and the like. The processor is further adapted to generate a medium, such as a display, based upon the determined relationships, wherein the processor is adapted to remove any logical components that are identified in each of the messages in the thread so that the generated medium does not include the redundant logical components (p. 8, line 16-p. 9, line 19). In a first display, messages are presented in a semi-linear message sequence in which embedded quotes are abbreviated, included messages are eliminated and links are provided to allow full access to the quotes (p. 4, lines 4-7; p. 5, lines 29-31; p. 10, lines 25-28). In a second display, blocks are presented that constitute responses to a particular passage as annotations to the passage in the original message via in-lining, margin text, framing, links or other similar display strategies (p. 4, lines 7-9; p. 5, lines 31-34; p. 10, line 28-p. 11, line 14).

C. Independent Claim 18

Claim 18 defines an information storage media (p. 5, lines 1-22; p. 6, lines 1-5). The information presents e-mail threads on a viewing area of a display (p. 10, line 25-p. 11, line 14). The information further identifies the logical components of each of the messages in a thread (p. 6, lines 6-10), which includes dividing the message into a main body and excerpts from other messages that are either embedded in the main body or suffixed, as well as decomposing these sections into group types, such as text-blocks, tables, contact information, and the like. The information further determines relationships between each of the messages in the thread using the logical components (p. 7, line 31-p. 8, line 15), which uses the logical components to match excerpts with their sources and to identify predecessor or predecessors for each message. If possible, each excerpt is matched to its source. Otherwise, predecessors are found based on a combination of evidence, including header fields, header fields of included messages, excerpted text, and the like. The information further generates a medium based upon the determined relationships (p. 8, line 16). The information

further removes any logical components that are identified in each of the messages in the thread so that the generated medium doe not include the redundant logical components (p. 8, line 17-p. 9, line 19). In a first presentation technique, messages are presented in a semi-linear message sequence in which embedded quotes are abbreviated, included messages are eliminated and links are provided to allow full access to the quotes (p. 4, lines 4-7; p. 5, lines 29-31). In a second presentation technique, blocks are presented that constitute responses to a particular passage as annotations to the passage in the original message via in-lining, margin text, framing, links or other similar display strategies (p. 4, lines 7-9; p. 5, lines 31-34).

D. Independent Claim 26

Claim 26 defines a computer system for presenting email threads comprising a computer processor (p. 5, lines 1-22; p. 6, lines 1-5). Logical components of each message in a thread are identified (p. 6, lines 6-10), which includes dividing the message into a main body and excerpts from other messages that are either embedded in the main body or suffixed, as well as decomposing these sections into group types, such as text-blocks, tables, contact information, and the like. Relationships between the messages in the thread using the logical components are determined (p. 7, line 31-p. 8, line 15), which uses the logical components to match excerpts with their sources and to identify predecessor or predecessors for each message. If possible, each excerpt is matched to its source. Otherwise, predecessors are found based on a combination of evidence, including header fields, header fields of included messages, excerpted text, and the like. A medium is generated based upon the determined relationships, wherein the e-mail threads are presented in the medium as semi-connected text, and wherein any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated medium does not include the redundant logical components (p. 8, line 16-p. 9, line 19). In a first presentation technique, messages are presented in a semi-linear message sequence

in which embedded quotes are abbreviated, included messages are eliminated and links are provided to allow full access to the quotes (p. 4, lines 4-7; p. 5, lines 29-31). In a second presentation technique, blocks are presented that constitute responses to a particular passage as annotations to the passage in the original message via in-lining, margin text, framing, links or other similar display strategies (p. 4, lines 7-9; p. 5, lines 31-34).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

A. Issue I

Whether Claims 1, 3-10, 12-18, and 20-27 stand properly rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,484,196 to Maurille ("Maurille") in view of U.S. Patent No. 6,044,395 to Costales et al. ("Costales"). The rejected claims do not stand or fall together. Accordingly, the rejections of Claims 1 and 3-9, 10 and 12-17, 18 and 20-25, and 26-27 are argued separately.

7. ARGUMENT

A. Issue I

Whether Claims 1, 3-10, 12-18, and 20-27 stand properly rejected under 35 U.S.C. § 103(a) as being obvious over Maurille and in view of Costales.

1. Legal Basis

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the examiner has the burden of proving that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there is a reasonable expectation of success; and (3) the combined references teach or suggest all the claim limitations. MPEP § 2143. A *prima facie* of obviousness case has not been shown. Appellant traverses the rejection.

2. U.S. Patent No. 6,484,196 issued to Maurille

The Maurille reference discloses communications board system with multiple modes that can be variously configured, including a threaded mail system that allows a user to send threaded email over the Internet (Col. 2, line 55-Col. 3, line 1; Col. 6, lines 40-41). A sender requests communication services using a client application that relays the request to a server program, which moderates all communications activities and updates a message repository to reflect the request (Col. 3, lines 3-15). A sender sends a message to a recipient by filling in a send message template and, upon receiving the message information, the server stores the pertinent information in a message table and updates message status fields and threading information (Col. 3, lines 29-37). The threading information enables the client application to display the message's history, along with that of other messages (Col. 3, lines 61-63), and includes a thread identifier generated by the server application, subject completed by the sender, and a sort number for the subject (Col. 10, lines 56-60). A thread includes a first level message and subsequent replies, which can be added to the thread until the thread is closed by an explicit acknowledgment issued by a thread participant (Col. 9, lines 1-4). An initial message is assumed to be a first level message that starts a new thread of conversation (Col. 10, lines 2-4).

3. U.S. Patent No. 6,044,395 issued to Costales

The Costales reference discloses a method and apparatus for distributing personalized email, which contains a message body for any given recipient that is identical for all recipients, but contains other portions of the message body that are unique for each recipient (Col. 2, lines 12-17). A first portion of an email message is sent, which contains one or more blocks of text that are each assigned different index values (Col. 2, lines 50-53). A second portion of the email message is sent, which contains information specific to a particular recipient and contains pointers to the index values (Col. 2, lines 53-57). The first and second portions together include information sufficient to form a complete personalized

email message for a particular recipient (Col. 2, lines 57-59).

4. Claims 1 and 3-9

The first prong of *prima facie* obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Initially, the examiner must show some teaching or suggestion to combine references that supports their use in combination. *See*, *Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such teaching or suggestion has not been shown.

Maurille teaches a multimodal communications board system that includes a threaded email system. Prior to sending a message, senders must fill out a message template and a message server uses the message information to perform a sequence of operations to update a messages table, including updating message status fields and threading information. *See*, *e.g.*, *Maurille*, Col. 10, line 18-Col. 11, line 7. The messages table identifies the name of a file that contains message body text, a user name of a message recipient, a comma delimited list of recipients, and a comma delimited list of carbon copy recipients. *Id.* at Col. 8, lines 29-47.

In contrast, Costales teaches a personalized email distribution system and method that attempts to avoid burdening available computing resources with high volume personalized email transmissions. *Costales*, Col. 2, lines 25-30. A client can send an individual email message or a common content "chunk," that is, information common to multiple email messages, plus pointers referencing the content chunks. *Id.* at Col. 4, lines 28-39. The client may send multiple messages, which each reference a content chunk that is transmitted only once, and the server, based on the pointers, inserts appropriate content chunks to create individual personalized email messages. *Id.* at Col. 4, lines 39-44

Both Maurille and Costales teach person-to-person email that can be sent from one sender to one recipient or to many recipients. However, the message

server taught by Maurille moderates all communications activities, including storing the name of a file that contains message body text and tracking individual senders and recipients for use as threading information. Maurille fails to provide a suggestion or motivation to be modified or combined with the personalized email distribution teachings of Costales, in which the message body text for each recipient can be indirectly specified through index values, instead of message body text as taught by Maurille. Moreover, Costales teaches away from Maurille by disallowing the tracking of threads. In Maurille, the threading information allows a client application to display a message's history, including any subsequent replies. In Costales, each personalized email message is different and constitutes a *separate and distinct* thread that originated from the same sender as each of the other personalized email messages. Maurille, though, fails to teach or suggest tracking multiple parallel threads for the same originating sender. As a result, one of ordinary skill in the art would not be motivated to modify or combine the teachings of Maurille and Costales, as the ability to track threads would be lost.

The second prong of *prima facie* obviousness requires a reasonable expectation of success. Obviousness may not be established by picking and choosing from an art reference only so much of the reference as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Although both Maurille and Costales teach conventional person-to-person email, modifying or combining the teachings of Maurille and Costales would disallow the tracking and use of threading information. Thus, one of ordinary skill in the art would have no reasonable expectation of success.

The third prong of *prima facie* obviousness requires that the combined references teach or suggest all the claim limitations. Claim 1 defines a method for presenting email threads. Maurille teaches using threading information that is updated by the message server moderating the communications activities between

the sender and the recipient, such that the relationships between all messages are progressively tracked. In contrast, Claim 1 recites *identifying* the logical components of each message in a thread and *determining* the relationships between the messages in the thread using the logical components, which is neither taught nor suggested by Maurille, in which threading information is expressly updated and stored as part of message relaying. In addition, Maurille teaches displaying messages with full threading information as relayed by the message server. *See*, *Maurille*, FIGURE 4B. In contrast, Claim 1 further recites *generating* a document based upon the determined relationships, which is neither taught nor suggested by Maurille, which displays a set of messages as sent using stored threading information. Finally, Costales teaches sending a first portion of an email message that contains one or more blocks of text with assigned index values and a second portion, which contains recipient-specific information and pointers to the index values. In contrast, Claim 1 further recites that any logical components that are identified in each of the messages in the thread are *removed* during the generating step so that the generated document does not include the redundant logical components, which is neither taught nor suggested by Costales, which inserts, not removes text blocks that would otherwise be redundant if sent as separate email messages. Consequently, the combined references fail to teach or suggest all the claim limitations.

The required showing to establish a *prima facie* of obviousness has not been met. There is no showing as to why one of ordinary skill in the art would have felt a suggestion or motivation to modify or combine the reference teachings of Maurille and Costales. The final Office action provides, "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Costales into the computer system of Maurille to have generated document does not include the redundant logical components because it would have provided the quality of systems or elements that are backed up with secondary resources." Final Off. Act., p. 3, first para. There are no such teachings or suggestions in either Maurille or Costales. Finding similar elements

in one or more references does not automatically render an invention unpatentable, nor may the invention be used as an instruction book on how to reconstruct the invention from the art references. *See Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Thus, a *prima facie* case of obviousness has not been shown with respect to Claim 1. Claims 3-9 are dependent on Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. As a *prima facie* case of obviousness has not been shown, withdrawal of the rejection of Claims 1 and 3-9 for obviousness under 35 U.S.C. 103(a) is respectfully requested.

5. Claims 10 and 12-17

The first prong of *prima facie* obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Initially, the examiner must show some teaching or suggestion to combine references that supports their use in combination. *See, Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such teaching or suggestion has not been shown.

Maurille teaches a multimodal communications board system that includes a threaded email system. Prior to sending a message, senders must fill out a message template and a message server uses the message information to perform a sequence of operations to update a messages table, including updating message status fields and threading information. *See, e.g., Maurille*, Col. 10, line 18-Col. 11, line 7. The messages table identifies the name of a file that contains message body text, a user name of a message recipient, a comma delimited list of recipients, and a comma delimited list of carbon copy recipients. *Id.* at Col. 8, lines 29-47.

In contrast, Costales teaches a personalized email distribution system and method that attempts to avoid burdening available computing resources with high

volume personalized email transmissions. *Costales*, Col. 2, lines 25-30. A client can send an individual email message or a common content "chunk," that is, information common to multiple email messages, plus pointers referencing the content chunks. *Id.* at Col. 4, lines 28-39. The client may send multiple messages, which each reference a content chunk that is transmitted only once, and the server, based on the pointers, inserts appropriate content chunks to create individual personalized email messages. *Id.* at Col. 4, lines 39-44

Both Maurille and Costales teach person-to-person email that can be sent from one sender to one recipient or to many recipients. However, the message server taught by Maurille moderates all communications activities, including storing the name of a file that contains message body text and tracking individual senders and recipients for use as threading information. Maurille fails to provide a suggestion or motivation to be modified or combined with the personalized email distribution teachings of Costales, in which the message body text for each recipient can be indirectly specified through index values, instead of message body text as taught by Maurille. Moreover, Costales teaches away from Maurille by disallowing the tracking of threads. In Maurille, the threading information allows a client application to display a message's history, including any subsequent replies. In Costales, each personalized email message is different and constitutes a *separate and distinct* thread that originated from the same sender as each of the other personalized email messages. Maurille, though, fails to teach or suggest tracking multiple parallel threads for the same originating sender. As a result, one of ordinary skill in the art would not be motivated to modify or combine the teachings of Maurille and Costales, as the ability to track threads would be lost.

The second prong of *prima facie* obviousness requires a reasonable expectation of success. Obviousness may not be established by picking and choosing from an art reference only so much of the reference as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Bausch &*

Lomb, Inc. v. Barnes-Hind, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Although both Maurille and Costales teach conventional person-to-person email, modifying or combining the teachings of Maurille and Costales would disallow the tracking and use of threading information. Thus, one of ordinary skill in the art would have no reasonable expectation of success.

The third prong of *prima facie* obviousness requires that the combined references teach or suggest all the claim limitations. Claim 10 defines a computer controlled display system. Maurille teaches using threading information that is updated by the message server moderating the communications activities between the sender and the recipient, such that the relationships between all messages are progressively tracked. In contrast, Claim 10 recites a processor that is adapted to *identify* the logical components of each message in a thread and to *determine* the relationships between each message in the thread using the logical components, which is neither taught nor suggested by Maurille, in which threading information is expressly updated and stored as part of message relaying. In addition, Maurille teaches displaying messages with full threading information as relayed by the message server. *See*, *Maurille*, FIGURE 4B. In contrast, Claim 10 recites a processor that is further adapted to *generate* a medium based upon the determined relationships, which is neither taught nor suggested by Maurille, which displays a set of messages as sent using stored threading information. Finally, Costales teaches sending a first portion of an email message that contains one or more blocks of text with assigned index values and a second portion, which contains recipient-specific information and pointers to the index values. In contrast, Claim 10 recites a processor that is further adapted to *remove* any logical components that are identified in each of the messages in the thread so that the generated medium does not include the redundant logical components, which is neither taught nor suggested by Costales, which inserts, not removes text blocks that would otherwise be redundant if sent as separate email messages. Consequently, the combined references fail to teach or suggest all the claim limitations.

The required showing to establish a *prima facie* of obviousness has not

been met. There is no showing as to why one of ordinary skill in the art would have felt a suggestion or motivation to modify or combine the reference teachings of Maurille and Costales. The final Office action provides, "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Costales into the computer system of Maurille to have generated document does not include the redundant logical components because it would have provided the quality of systems or elements that are backed up with secondary resources." Final Off. Act., p. 3, first para. There are no such teachings or suggestions in either Maurille or Costales. Finding similar elements in one or more references does not automatically render an invention unpatentable, nor may the invention be used as an instruction book on how to reconstruct the invention from the art references. *See Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Thus, a *prima facie* case of obviousness has not been shown with respect to Claim 10. Claims 12-17 are dependent on Claim 10 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. As a *prima facie* case of obviousness has not been shown, withdrawal of the rejection of Claims 10 and 12-17 for obviousness under 35 U.S.C. 103(a) is respectfully requested.

6. Claims 18 and 20-25

The first prong of *prima facie* obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Initially, the examiner must show some teaching or suggestion to combine references that supports their use in combination. *See, Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such teaching or suggestion has not been shown.

Maurille teaches a multimodal communications board system that includes a threaded email system. Prior to sending a message, senders must fill out a

message template and a message server uses the message information to perform a sequence of operations to update a messages table, including updating message status fields and threading information. *See, e.g., Maurille*, Col. 10, line 18-Col. 11, line 7. The messages table identifies the name of a file that contains message body text, a user name of a message recipient, a comma delimited list of recipients, and a comma delimited list of carbon copy recipients. *Id.* at Col. 8, lines 29-47.

In contrast, Costales teaches a personalized email distribution system and method that attempts to avoid burdening available computing resources with high volume personalized email transmissions. *Costales*, Col. 2, lines 25-30. A client can send an individual email message or a common content "chunk," that is, information common to multiple email messages, plus pointers referencing the content chunks. *Id.* at Col. 4, lines 28-39. The client may send multiple messages, which each reference a content chunk that is transmitted only once, and the server, based on the pointers, inserts appropriate content chunks to create individual personalized email messages. *Id.* at Col. 4, lines 39-44

Both Maurille and Costales teach person-to-person email that can be sent from one sender to one recipient or to many recipients. However, the message server taught by Maurille moderates all communications activities, including storing the name of a file that contains message body text and tracking individual senders and recipients for use as threading information. Maurille fails to provide a suggestion or motivation to be modified or combined with the personalized email distribution teachings of Costales, in which the message body text for each recipient can be indirectly specified through index values, instead of message body text as taught by Maurille. Moreover, Costales teaches away from Maurille by disallowing the tracking of threads. In Maurille, the threading information allows a client application to display a message's history, including any subsequent replies. In Costales, each personalized email message is different and constitutes a *separate and distinct* thread that originated from the same sender as each of the other personalized email messages. Maurille, though, fails to teach or

suggest tracking multiple parallel threads for the same originating sender. As a result, one of ordinary skill in the art would not be motivated to modify or combine the teachings of Maurille and Costales, as the ability to track threads would be lost.

The second prong of *prima facie* obviousness requires a reasonable expectation of success. Obviousness may not be established by picking and choosing from an art reference only so much of the reference as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Although both Maurille and Costales teach conventional person-to-person email, modifying or combining the teachings of Maurille and Costales would disallow the tracking and use of threading information. Thus, one of ordinary skill in the art would have no reasonable expectation of success.

The third prong of *prima facie* obviousness requires that the combined references teach or suggest all the claim limitations. Claim 18 defines an information storage media. Maurille teaches using threading information that is updated by the message server moderating the communications activities between the sender and the recipient, such that the relationships between all messages are progressively tracked. In contrast, Claim 18 recites information that *identifies* the logical components of each of the messages in a thread and information that *determines* relationships between each of the messages in the thread using the logical components, which is neither taught nor suggested by Maurille, in which threading information is expressly updated and stored as part of message relaying. In addition, Maurille teaches displaying messages with full threading information as relayed by the message server. *See*, *Maurille*, FIGURE 4B. In contrast, Claim 18 further recites information that *generates* a medium based upon the determined relationships, which is neither taught nor suggested by Maurille, which displays a set of messages as sent using stored threading information. Finally, Costales teaches sending a first portion of an email message that contains one or more

blocks of text with assigned index values and a second portion, which contains recipient-specific information and pointers to the index values. In contrast, Claim 18 further recites information that *removes* any logical components that are identified in each of the messages in the thread so that the generated medium doe not include the redundant logical components, which is neither taught nor suggested by Costales, which inserts, not removes text blocks that would otherwise be redundant if sent as separate email messages. Consequently, the combined references fail to teach or suggest all the claim limitations.

The required showing to establish a *prima facie* of obviousness has not been met. There is no showing as to why one of ordinary skill in the art would have felt a suggestion or motivation to modify or combine the reference teachings of Maurille and Costales. The final Office action provides, "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Costales into the computer system of Maurille to have generated document does not include the redundant logical components because it would have provided the quality of systems or elements that are backed up with secondary resources." Final Off. Act., p. 3, first para. There are no such teachings or suggestions in either Maurille or Costales. Finding similar elements in one or more references does not automatically render an invention unpatentable, nor may the invention be used as an instruction book on how to reconstruct the invention from the art references. *See Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Thus, a *prima facie* case of obviousness has not been shown with respect to Claim 18. Claims 20-25 are dependent on Claim 18 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. As a *prima facie* case of obviousness has not been shown, withdrawal of the rejection of Claims 18 and 20-25 for obviousness under 35 U.S.C. 103(a) is respectfully requested.

7. Claims 26-27

The first prong of *prima facie* obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Initially, the examiner must show some teaching or suggestion to combine references that supports their use in combination. *See, Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such teaching or suggestion has not been shown.

Maurille teaches a multimodal communications board system that includes a threaded email system. Prior to sending a message, senders must fill out a message template and a message server uses the message information to perform a sequence of operations to update a messages table, including updating message status fields and threading information. *See, e.g., Maurille*, Col. 10, line 18-Col. 11, line 7. The messages table identifies the name of a file that contains message body text, a user name of a message recipient, a comma delimited list of recipients, and a comma delimited list of carbon copy recipients. *Id.* at Col. 8, lines 29-47.

In contrast, Costales teaches a personalized email distribution system and method that attempts to avoid burdening available computing resources with high volume personalized email transmissions. *Costales*, Col. 2, lines 25-30. A client can send an individual email message or a common content "chunk," that is, information common to multiple email messages, plus pointers referencing the content chunks. *Id.* at Col. 4, lines 28-39. The client may send multiple messages, which each reference a content chunk that is transmitted only once, and the server, based on the pointers, inserts appropriate content chunks to create individual personalized email messages. *Id.* at Col. 4, lines 39-44

Both Maurille and Costales teach person-to-person email that can be sent from one sender to one recipient or to many recipients. However, the message server taught by Maurille moderates all communications activities, including storing the name of a file that contains message body text and tracking individual

senders and recipients for use as threading information. Maurille fails to provide a suggestion or motivation to be modified or combined with the personalized email distribution teachings of Costales, in which the message body text for each recipient can be indirectly specified through index values, instead of message body text as taught by Maurille. Moreover, Costales teaches away from Maurille by disallowing the tracking of threads. In Maurille, the threading information allows a client application to display a message's history, including any subsequent replies. In Costales, each personalized email message is different and constitutes a *separate and distinct* thread that originated from the same sender as each of the other personalized email messages. Maurille, though, fails to teach or suggest tracking multiple parallel threads for the same originating sender. As a result, one of ordinary skill in the art would not be motivated to modify or combine the teachings of Maurille and Costales, as the ability to track threads would be lost.

The second prong of *prima facie* obviousness requires a reasonable expectation of success. Obviousness may not be established by picking and choosing from an art reference only so much of the reference as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Although both Maurille and Costales teach conventional person-to-person email, modifying or combining the teachings of Maurille and Costales would disallow the tracking and use of threading information. Thus, one of ordinary skill in the art would have no reasonable expectation of success.

The third prong of *prima facie* obviousness requires that the combined references teach or suggest all the claim limitations. Claim 26 defines a computer system for presenting email threads. Maurille teaches using threading information that is updated by the message server moderating the communications activities between the sender and the recipient, such that the relationships between all messages are progressively tracked. In contrast, Claim 26 recites (a)

identifying logical components of each message in a thread; and (b) *determining* relationships between the messages in the thread using the logical components, which is neither taught nor suggested by Maurille, in which threading information is expressly updated and stored as part of message relaying. In addition, Maurille teaches displaying messages with full threading information as relayed by the message server. *See*, *Maurille*, FIGURE 4B. In contrast, Claim 26 further recites (c) *generating* a medium based upon the determined relationships, wherein the e-mail threads are presented in the medium as semi-connected text, which is neither taught nor suggested by Maurille, which displays a set of messages as sent using stored threading information. Finally, Costales teaches sending a first portion of an email message that contains one or more blocks of text with assigned index values and a second portion, which contains recipient-specific information and pointers to the index values. In contrast, Claim 26 further recites that any logical components that are identified in each of the messages in the thread are *removed* during the generating step so that the generated medium does not include the redundant logical components, which is neither taught nor suggested by Costales, which inserts, not removes text blocks that would otherwise be redundant if sent as separate email messages. Consequently, the combined references fail to teach or suggest all the claim limitations.

The required showing to establish a *prima facie* of obviousness has not been met. There is no showing as to why one of ordinary skill in the art would have felt a suggestion or motivation to modify or combine the reference teachings of Maurille and Costales. The final Office action provides, "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Costales into the computer system of Maurille to have generated document does not include the redundant logical components because it would have provided the quality of systems or elements that are backed up with secondary resources." Final Off. Act., p. 3, first para. There are no such teachings or suggestions in either Maurille or Costales. Finding similar elements in one or more references does not automatically render an invention

unpatentable, nor may the invention be used as an instruction book on how to reconstruct the invention from the art references. *See Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Thus, a *prima facie* case of obviousness has not been shown with respect to Claim 26. Claim 27 is dependent on Claim 26 and is patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. As a *prima facie* case of obviousness has not been shown, withdrawal of the rejection of Claims 26 and 27 for obviousness under 35 U.S.C. 103(a) is respectfully requested.

In view of the foregoing arguments, Appellant respectfully submits that the rejections under 35 U.S.C. § 103(a) cannot be maintained and should be withdrawn. A Notice of Allowance is earnestly solicited. Appellant's undersigned attorney can be reached at (206) 381-3900. The Appeal Brief fee is included with the Appeal Brief

Dated: January 17, 2006

By: _____
Patrick J.S. Inouye, Esq.
Reg. No. 40,297

Law Offices of Patrick J.S. Inouye
810 Third Avenue
Suite 258
Seattle, WA 98104

Telephone: (206) 381-3900
Facsimile: (206) 381-3999

10. CLAIMS APPENDIX

1. (previously presented): A method for presenting email threads, comprising the steps of:

identifying the logical components of each message in a thread;

determining the relationships between the messages in the thread using the logical components; and

generating a document based upon the determined relationships,

wherein any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated document does not include the redundant logical components.

2. (canceled).

3. (original): The method of claim 1, wherein the step of identifying logical components comprises generating a message tree that includes nodes that recursively divide each of the messages into a main body, nested excerpts from other messages, and at least one subdivision wherein each subdivision is divided into lowest-level logical components.

4. (original): The method of claim 3, wherein the step of generating a message tree comprises:

performing a top-down, recursive descent analysis to recursively divide each of the messages into sections, each section being one of a main-body of the message, an incorporated excerpt, a suffixed excerpt, the body of an excerpt, and an excerpt within an excerpt; and

decomposing each section into logical components using a weighted finite-state machine.

5. (original): The method of claim 4, wherein the step of decomposing comprises:

logically concatenating subsections of the body that is separated by incorporated excerpts; and

applying a weighted finite state machine to the result.

6. (original): The method of claim 4, wherein the step of decomposing comprises:

building a weighted network using a weighted finite state grammar;

identifying the maximally weighted path through the network; and

traversing the maximally weighted path to identify the logical components of the section.

7. (original): The method of claim 1, wherein the document includes a compressed form of each of the messages.

8. (original): The method of claim 7, wherein each of the compressed forms comprises non-extraneous parts of the primary text and abbreviated forms of incorporated excerpts.

9. (original): The method of claim 1, wherein the document includes a replies as annotations form for each of the messages.

10. (previously presented): A computer controlled display system comprising:

a display for presenting e-mail threads on a viewing area of the display; and

a processor that is adapted to identify the logical components of each message in a thread, determine the relationships between each message in the thread using the logical components, and generate a medium based upon the determined relationships,

wherein the processor is adapted to remove any logical components that are identified in each of the messages in the thread so that the generated medium does not include the redundant logical components.

11. (canceled).

12. (original): The system of claim 10, wherein the processor is adapted to generate a message tree that includes nodes that divide each message into a main body and into excerpts from other messages and further into lowest-level logical components.

13. (original): The system of claim 12, wherein the processor is adapted to perform a top-down, recursive descent analysis to create nodes of the message tree and to analyze divided extents using a weighted finite state machine.

14. (original): The system of claim 12, wherein the processor is adapted to identify the maximally weighted path through the weighted finite state machine, and to develop a sub tree by traversing the maximally weighted path.

15. (original): The system of claim 10, wherein the document includes a compressed form of each of the messages.

16. (original): The system of claim 15, wherein each of the compressed form contains non-extraneous parts of the primary text.

17. (original): The system of claim 10, wherein the document includes a replies as annotations form for each of the messages.

18. (previously presented): An information storage media comprising:

information that presents e-mail threads on a viewing area of a display;

information that identifies the logical components of each of the messages in a thread;

information that determines relationships between each of the messages in the thread using the logical components;

information that generates a medium based upon the determined relationships; and

information that removes any logical components that are identified in each of the messages in the thread so that the generated medium doe not include the redundant logical components.

19. (canceled).

20. (original): The information storage media of claim 18, further comprising information that generates a message tree that includes nodes that divide each message into a main body and into excerpts from other messages and further into lowest-level logical components.

21. (original): The information storage media of claim 18, further comprising:

information that performs a top-down, recursive descent analysis to create some nodes of the message tree; and

information that analyzes divided extents using a weighted finite state machine.

22. (original): The information storage media of claim 21, further comprising;

information that identifies a maximally weighted path through the weighted finite state machine; and

information that develops a sub tree by traversing the maximally weighted path.

23. (original): The information storage media of claim 18, wherein the medium includes a compressed form of each of the messages.

24. (original): The system of claim 23, wherein each of the compressed form contains non-extraneous parts of the primary text.

25. (original): The system of claim 18, wherein the medium includes a replies as annotations form for each of the messages.

26. (previously presented): A computer system for presenting email threads comprising a computer processor for: (a) identifying logical components of each message in a thread; (b) determining relationships between the messages in the thread using the logical components; and (c) generating a medium based upon the determined relationships, wherein the e-mail threads are presented in the medium as semi-connected text, and wherein any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated medium does not include the redundant logical components.

27. (original): The system of claim 26, wherein the medium is one of a human readable document and a computer readable document.

11. EVIDENCE APPENDIX

None.

12. RELATED PROCEEDINGS APPENDIX

None.